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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/808,468      | 03/14/2001  | Thomas Dresch        | 840.066202          | 4227             |

7590 04/01/2002

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EXAMINER

NGUYEN, KIET TUAN

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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2881

DATE MAILED: 04/01/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/808,468

Applicant(s)

Dresch et al.

Examiner

K. NGUYEN

Group Art Unit

2881

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

## Status

- ☒ Responsive to communication(s) filed on 01-18-02
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 11-13 is/are pending in the application.
- Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 11-13 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
  - ☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been received.
  - ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.
  - ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other \_\_\_\_\_

Office Action Summary

***Rejection Under 35 U.S.C. 112, Second Paragraph***

Claim 12 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 12 is indefinite for reciting the limitation "the time relationship ... said analyzer" in lines 2-4. Since the grammatical errors are appeared in this limitation for example means to control the time relationship in lines 1-2, and said multipole ion guide pulse time controls the duty cycle of said analyzer in lines 3-4. And what and/or how is the time to raise the means for pulsing the ions? How is the multipole ion guide pulse time that controls the duty cycle of said analyzer?

Claim 12 recites the limitation "said multipole ion guide pulse time" in lines 3-4. There is insufficient antecedent basis for this limitation in the claim.

Claim 12 recites the limitation "the duty cycle" in line 4. There is insufficient antecedent basis for this limitation in the claim.

***Double Patenting Rejection***

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claims 11-13 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1 and 10 of prior U.S. Patent No. 6,020,586. This is a double patenting rejection.

It is noted that claim 12, as understood by the meaning of 112, second paragraph above, is applied double patenting rejection under 35 U.S.C. 101.

The limitation as recited in part (d) of claim 1 of the Patent No. 6,020,586 is considered to be inherent in claim 11 of the application SN: 09/808,468, since the multipole ion guide is a two dimensional and used to trap ions in and release ions from the ion guide.

The limitations as recited in claims 12 and 13 of the application SN: 09/808,468 are considered to be inherent in claims 1 and 10 of the Patent No. 6,020,586, since the ions entering the ion guide during the ion trapping and ion release as recited in claim 10 of the Patent No. 6,020,586 is to prevent excessive charge buildup in the ion guide and to perform the duty cycle of the analyzer.

***Rejection Under 35 U.S.C. 102(b)***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 11-13 are rejected under 35 U.S.C. 102(b) as being anticipated by Davis et al.

It is noted that claim 12, as understood by the meaning of 112, second paragraph above, is rejected under 35 U.S.C. 102(b).

Davis et al. disclose, in figs. 1-8(b), a mass spectrometry system. The system includes an ion source 10 for producing ions; an ion storage quadrupole 20 which is a two dimensional multipole ion guide (see col. 5, lines 7-8; and col. 9, line 60 to col. 10, line 6); an ion pulsing region 30 having a laser pulse for pulsing the ions; a time of flight mass analyzer 40; and a detector (see fig. 5). The ions in the quadrupole 20 are scanned at a scan rate for preventing excessive charge buildup in the quadrupole (see col. 7, lines 40-45). Means for controlling the time relationship between the time of the laser pulse and the time of the quadrupole is used to control the duty cycle of the analyzer (see col. 11, line 50-68).

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- 1) Muga discloses a time of flight mass spectrometer having a quadrupole lens;
- 2) Smith et al. disclose a mass spectrometer having a time of flight and a quadrupole;
- 3) Buttrill, Jr. et al. disclose an apparatus having an ion trap and time of flight device; and
- 4) Whitehouse et al. disclose a mass spectrometer having a multipole ion guide and a time of flight device.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner *Kiet T. Nguyen* whose telephone number is (703) 308-4855.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0956.

Papers related to Art Unit 2881 applications **only** may be submitted to Art Unit 2881 by facsimile transmission. Any transmission not to be considered an official response must be clearly marked "**DRAFT**". The faxing of such papers must conform with the notice published in the

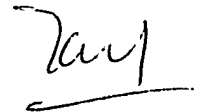
Application/Control Number: 09/808,468  
Attorney's Docket No. 840.066202

Art Unit: 2881  
Paper No. 8

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Official Gazette, 1096 OG 30 (November 15, 1989). The Art Unit 2881 Fax Center number is (703) 308-7723.

*K.T.N/Primary*  
March 25, 2002

  
KIET T. NGUYEN  
PRIMARY EXAMINER